

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of: )  
 )  
Michael D. Hooven )  
 )  
Serial No.: 10/038,506 )  
 )  
Filed: November 9, 2001 )  
 )  
Group Art No.: 3739 )  
 )  
Confirmation No. 6492 )  
 )  
Examiner: Victoria W. Chen )  
 )  
For: TRANSMURAL ABLATION DEVICE )  
WITH PARALLEL JAWS )

**RESPONSE TO OFFICE ACTION OF AUGUST 24, 2007**

In the present invention, claims 1-7 are pending with claims 1 and 3 as the only independent claims. Claims 2 and 4-7 depend directly or indirectly from one of claims 1 or 3.

**The Claims Are Not Anticipated By Yates**

The Office Action rejects the claimed invention under 35 U.S.C. Section 102(e) based on U.S. Patent No. 5,403,312 to Yates (hereinafter referred to as Yates). However, it is respectfully submitted that Yates lacks claimed features such that it cannot anticipate the claims.

None of the embodiments in Yates discloses electrodes that are in face-to-face relation. Rather, each disclosed embodiment teaches electrodes that are electrically isolated and offset from each other. For example, Yates discloses a cutting instrument 10 in Figures 1-9 which includes electrically isolated first and second poles 52, 18. (See Figure 6). As clearly taught in Yates, "[t]he anvil [or second pole] 18 is isolated from the first pole 52 by the U-shaped insulating material 55." (Column 6, lines 22-24) (emphasis added). Similarly, Yates teaches that the first and second poles 151, 152, 251, 252, 351, 352, 451, 452, 551, 552, 651, 652, 751, 752, 851, 852, 933a, 952 for each of its

other disclosed embodiments are electrically isolated from each other by a respective insulator 155, 255, 355b, 455a, 755a, 755b, 855, 955 (or unnumbered insulating material in Figures 15 and 16). Yates is clear and consistent in its specification that the poles are “electrically isolated from each other” (column 9, lines 8-9 or lines 34-35 or line 60; emphasis added), that there is “insulating material between staggered electrodes” (column 9, lines 44-45), or that an insulator “electrically isolates” the poles from each other (column 10, lines 8-9).

It is noted that Figure 18, which is relied upon by the Examiner, shows a cross section of the embodiment shown in Figure 17, and also does not disclose face-to-face electrodes. In Figure 17, electrodes 751, 752 are electrically isolated and offset (or staggered) from each other by insulating material 755a, 755b. (Column 9, lines 57-61). In Figure 18, staggered electrodes 752 on an upper jaw are shown in dashed lines to represent their offset position with respect to staggered electrodes 751 on a lower jaw. The relevant portion of Yates describes “[a]s can be seen from FIG. 18, the poles 751, 752 are vertically aligned, but as illustrated in FIG. 17, are staggered so that when the jaws 732, 734 are closed, the poles are electrically isolated from each other by insulators 755a, 755b.” (Column 9, lines 57-61) (Emphasis added). It is noted that the poles 751, 752 are referred to as “vertically aligned” relative to Figure 18 only to the extent that they are positioned on either side of a respective knife channel 726, 742. Thus, the electrodes in Figure 18 of Yates are clearly electrically isolated and offset from each other and, as such, are not in face-to-face relation, in contrast to the claimed invention.

Based on the above, it is respectfully submitted that Yates does not anticipate the claimed invention, which includes, inter alia, that the first and second electrodes are in face-to-face relation. By way of example, this claimed feature is shown and described at paragraph 148, 149 and Figures 1, 7, 38-39, 41-51 in the present application.

As Yates clearly lacks the claimed features, withdrawal of this rejection is respectfully requested.

#### **The Claims Would Not Have Been Obvious In View Of Yates**

It also would not be obvious to modify the electrodes disclosed in Yates. Yates expressly requires that the electrodes must be electrically isolated and/or offset from one another. (Column 2, line 62 to Column 3, line 2). As described at column 3, lines

28-32, Yates teaches the importance of “insulation or isolation of the opposite poles from each other on the instrument” because it “permits tissue compression without shorting of the instrument poles or electrical arcing common in bipolar instruments.” (emphasis added). Accordingly, Yates clearly teaches away from electrodes that are face-to-face relation, in contrast to the claimed invention, such that the claimed invention would not have been obvious in view of Yates.

### **Yates Does Not Teach Or Suggest Jaws That Are Parallel**

The Examiner relies upon jaws 732, 734 disclosed in Figure 17 as teaching or suggesting that “at least portions of the jaws are parallel through a range of tissue clamping spacing,” as recited in the claims. (emphasis added). However, it is noted that the embodiment in Figure 17, and all other of Yates’ embodiments, teaches that the jaws are pivotable.

Throughout its disclosure, Yates consistently teaches and suggests only pivotable jaws such as shown in Figures 1-4 and 17. In particular, Yates describes an instrument that employs a sheath 38 over a camming surface 27 to pivot the jaws to a closed position. (Column 5, lines 56-60, see Figures 3 and 4). Yates clearly does not disclose any other type of closure. There is no suggestion of parallel jaws throughout a range of tissue clamping spacing, as recited in the claims.

Thus, the end effector in Figure 17 of Yates does not disclose or suggest that at least portions of the jaws are parallel through a range of tissue clamping spacing, in contrast to the claims.

### **Conclusion**

For all the above reasons, it is respectfully requested that the claimed subject matter is not anticipated and would not have been obvious to a person of ordinary skill in the relevant field based on Yates. It is further respectfully requested that the pending claims be reconsidered and allowed.

Respectfully submitted,

Date: November 19,2007

By: /Renée C. Barthel/  
Renée C. Barthel, Esq.  
Registration No. 48,356  
Cook, Alex, McFarron, Manzo, Cummings  
& Mehler, Ltd.  
200 West Adams St., Ste. 2850,  
Chicago, IL 60606  
Tel (312) 236-8500